Docket No. 030158   Serial No. 10/665,747

<u>REMARKS/ARGUMENTS</u>

Claims 1-9, 11-32, 34-42, and 44-49 remain pending in the application. Applicant, by this paper, amends claims 1, 4, 9, 11, 13, 29, 32, 34, 40, 42, and 44, and cancels claims 10, 33, and 43 without prejudice.

<u>Discussion of Rejections Under 35 U.S.C. §103</u>

Claims 1-13, 15-18, 20-26, and 28-49 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent Publication No. 20030134646 to Forrester (hereinafter Forrester) in view of U.S. Patent Application Publication No. 20020184418 to Blight (hereinafter Blight). Claims 10, 33, and 43 were canceled, rendering moot the rejection of those claims.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art reference, or references when combined, must teach or suggest all of the claim limitations.

Claim 1 recites a position determination system that includes "a display to display non position information data based on the determined position." As described in Applicant's Specification, "the displayed data may be non-position information, such as sales information, advertisements, and the like related to a store located proximate the predetermined position of the mobile communications device." *Application*, at paragraph [0011]. This feature is not taught nor suggested by Forrester nor Blight.

The Office Action, in the rejection of original claim 10, argues that Forrester describes "wherein the displayed data based on the determined position is non position information (col. 3, par. [0029-0030])." *Office Action*, dated Feb. 9, 2006, at page 5. However, the cited paragraphs of Forrester do not describe any data that is displayed, and do not describe non-position information.

The cited paragraphs of Forrester describe the process of determining the position of a device using GPS and a PDE. Paragraph [0029] describes how PDEs track locations of GPS satellites using almanac information. A device receiving a position request communicates with a PDE to determine which of the GPS satellites is visible. The term "visible" in this

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context refers to those satellites which should be above the horizon relative to the location of the device. The term "visible" has no relation to a display nor to non-position information that is displayed.

The information that is sent to the device includes acquisition assist (AA) information and sensitivity assist (SA) information. Clearly, the AA and SA information relates to position determination, because the information relates to acquiring the GPS satellite signals. Furthermore, Forrester provides no discussion to even suggest that such information is displayed. Indeed, a user would likely have no idea how to interpret the AA and SA information even if it was displayed.

Paragraph [0030] of Forrester describes using the AA and SA information to improve the sensitivity of the receiver and to allow for making a position determination in approximately 2 seconds. Again, Forrester fails to describe any non position information and fails to describe displaying such non position information data.

The Office Action does not contend that Blight describes displaying such non position information data. Thus, Forrester and Blight, whether alone or in combination, fail to render claim 1 obvious, because the cited references, whether alone or in combination, fail to teach or suggest all claimed features. Applicant respectfully requests reconsideration and allowance of claim 1.

Claims 29 and 40 include similar features to that discussed above in relation to claim 1. In particular, claim 29 includes "means for displaying non position information data based on the determined position." Similarly, claim 40 includes "displaying non position information data based on the determined position." Therefore, claims 29 and 40 are believed to be allowable at least for the reason discussed above in relation to claim 1. Applicant respectfully requests reconsideration and allowance of claims 29 and 40.

Claim 20 recites a position determination system. The system includes "a position determining entity to determine the position of the mobile communication device based on the data received from the GPS satellites, *if available with an acceptable error range*, the communication signals from the base transceiver station, *if available with an acceptable error range*, and the data received from the network wireless access point." (*emphasis added*). Neither Forrester nor Blight describe the claimed feature.

Claims 20 includes determining a position of the mobile communication device data from GPS satellites, communication signals from base transceiver station, and a network

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wireless access point. However, claim 20 includes the conditional language "*if available with an acceptable error range*" when referring to position determination based on the data from the GPS satellites and communication signals from the base transceiver station.

The cited references fail to describe or suggest any acceptable error range associated with position determination based on GPS satellites and fail to describe or suggest any acceptable error range for position determination based on communication signals from a base transceiver station. The Office Action cites Forrester, paragraphs [0031-0032] as describing the conditional language "*if available with an acceptable error range*" when referring to position determination based on the data from the GPS satellites. *Office Action*, at page 7. However, the cited paragraphs from Forrester merely describe GPS receiver sensitivity and, in particular, describes the structure of the coarse acquisition code in a GPS signal and purported limitations on integration time. This discussion has no relation to acceptable error range for position determination.

Additionally, the cited references fail to describe any situation having "a position determining entity to determine the position of the mobile communication device based on ... the communication signals from the base transceiver station, *if available with an acceptable error range*." Indeed, the Office Action fails to provide any citation to support the contention that the feature is described in the references.

Thus, Forrester and Blight, whether alone or in combination, fail to render claim 20 obvious, because the cited references, whether alone or in combination, fail to teach or suggest all claimed features. Applicant respectfully requests reconsideration and allowance of claim 20.

Discussion of Dependent Claims

Claims 2-9, 11-19, 21-28, 30-32, 34-39, 41-42, and 44-49 depend from one of claims 1, 20, 29, or 40 and are believed to be allowable at least for the reason that they depend from an allowable base claim. Each of the dependent claims may have patentable features that distinguish over the prior art, but discussion of each individual claim is unnecessary in light of the allowability of the independent base claims.

For example, claims 16, 18, 37, 39, 47, and 49 each include similar features of determining a position based on a weighted combination of information, whether GPS satellite data or communication signals from a base transceiver station. These features are not

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taught in any of the cited references. The Office Action contends that these features are described in Forrester, at paragraphs [0020-0021] and [0015-0019]. *See, Office Action,* at page 6. However, these cited paragraphs fail to describe weighted combination of data.

The Office Action states that "'RF generated by weighted combination is inherently' of the data received from the GPS satellites and data from the wireless access point." [*sic*] *Office Action,* at page 6. If the argument provided in the Office Action is interpreted to mean that RF signals are inherently weighted combinations, such an argument is incorrect. IN order for something to be inherent, it must be a necessary result. A mere probability is not sufficient for inherency. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert,* 9 F.3d 1531, 1534 (Fed. Cir. 1993).

Clearly, RF signals are not necessarily weighted combinations. The cited references fail to describe any weighting of RF signals as alleged by the Examiner. Indeed, if RF signals were inherently weighted combinations, Applicant requests the Examiner provide a citation to show that such weighted combinations are somehow necessarily the result. Applicant contends the weighted combinations cannot be inherent. Furthermore, the claims do not require a weighted combination of RF signals. The Examiner has not provided any explanation as to how the supposed inherent disclosure of weighted RF signals relates to the claim language.

Applicant reiterates that it is unnecessary to discuss the distinguishing factors in each dependent claim based on the dependence on allowable independent claims. Applicant respectfully requests reconsideration and allowance of claims 2-9, 11-19, 21-28, 30-32, 34-39, 41-42, and 44-49.

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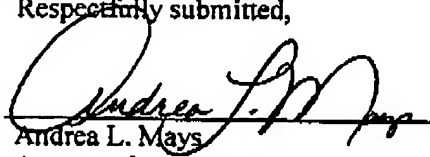
CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. Applicants therefore respectfully request that a timely Notice of Allowance be issued in this case.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned.

Respectfully submitted,

Dated: _____May 9, 2006_____   By: _____
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